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Practitioner's Docket No. 6029-7996

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Milbrandt et al.

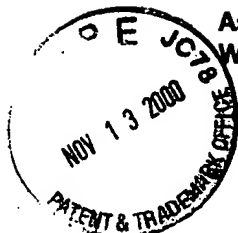
Application No.: 09/220,920
 Filed: December 24, 1998
 For: Artemin, A Novel Neurotrophic Factor

Group No. 1646

Examiner: Prema Mertz, Ph.D.

#13
P. 9
11/20/00

Assistant Commissioner for Patents
 Washington, D.C. 20231



STATEMENT FOR INFORMATION DISCLOSURE UNDER
 37 C.F.R. § 1.97(e)

NOTE: A statement must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement." 37 C.F.R. § 1.97(e).

NOTE: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19.

NOTE: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications, even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: November 8, 2000

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office. (703) _____

Signature

Elie H. Gendloff
 (type or print name of person certifying)

(Statement for Information Disclosure under 37 C.F.R. § 1.97(e) [6-8]—page 1 of 4)

130.00 OP

11/15/2000 NR00CHAI 00000005 09220920

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(3) every other person who is substantially involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. § 1.56(c).

STATEMENT

2. I, the person(s) signing below state:

- ☐ that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. § 1.97(e)(1).

NOTE: The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

OR

- ☒ that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. § 1.97(e)(2).

NOTE: "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT

3. The person making this statement is

(check each applicable item)

- (a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

- (b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. § 1.56(c)) and who signs below.

SIGNATURE OF PERSON MAKING STATEMENT

(type name of person who is signing)

Address of person who is signing

(c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

- ☒ supplied by the inventor(s).
- ☐ supplied by an individual designated in § 1.56(c).
- ☐ in the practitioner's file.

Reg. No.: 44,704

Tel. No. (314) 727-5188

Customer No.:


SIGNATURE OF PRACTITIONER

Elie H. Gendloff

(type or print name of practitioner)

7733 Forsyth Blvd., 14th Floor

P.O. Address

St. Louis, MO 63105

Practitioner's Docket No. 6029-7996

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARKS OFFICE

In re application of: Milbrandt et al.

Application No.: 0 9/ 220,920

Group No. 1646

Filed: December 24, 1998

Examiner: Prema Mertz, Ph.D.

For: Artemin, A Novel Neurotrophic Factor

Assistant Commissioner for Patents:

Washington, D.C. 20231

ATTENTION: GROUP DIRECTOR

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT AFTER
MAILING DATE OF FINAL ACTION OR NOTICE OF ALLOWANCE
BUT BEFORE PAYMENT OF ISSUE FEE (37 C.F.R. § 1.97(d))

NOTE: An information disclosure statement shall be considered by the Office if filed after the mailing date of either (1) a final action under § 1.113 or (2) a notice of allowance under § 1.311, whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by: (i) a statement as specified in paragraph (e) of section 1.97, (ii) a petition requesting consideration of the information disclosure statement, and (iii) the petition fee set forth in § 1.17(f).

NOTE: If the information disclosure statement that contains the items required by 37 C.F.R. § 1.97(d) is filed before, or simultaneously with, the payment of the issue fee, then it will be considered. See Notice of April 20, 1992 (1138 O.G. 37-41, 40) and 37 C.F.R. § 1.97(d).

TIME OF TRANSMITTAL OF ACCOMPANYING
INFORMATION DISCLOSURE STATEMENT

1. The information disclosure statement transmitted herewith is being filed after a final action under § 1.113, or a notice of allowance under § 1.311, whichever occurs first, but before, or simultaneously with, the payment of the issue fee.

WARNING: "A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63).

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office.

Date: November 8, 2000

Signature

Elie H. Gendloff

(type or print name of person certifying)

(Transmittal of Information Disclosure Statement after Mailing Date of Final Action or Notice of Allowance But before Payment of Issue Fee [6-5]—page 1 of 2)

STATEMENT, PETITION AND FEE

2. In accordance with the requirements of 37 C.F.R. § 1.97(d):

- A. Accompanying this transmittal is a statement, as specified in 37 C.F.R. § 1.97(e).
- B. Applicant hereby petitions for the consideration of the accompanying information disclosure statement. 37 C.F.R. § 1.97(d)(2).
- C. Applicant submits the petition fee set forth in § 1.17(i) (\$130.00).

NOTE: "The petition should be directed to the Group Director of the examining group handling the application. The petition need do nothing more than request consideration of the information being submitted." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

FEE DUE

3. Petition fee due (§ 1.17(i)): \$130.00

METHOD OF PAYMENT OF FEE

4.

- ☒ Attached is a check for \$130.00.
- ☐ Charge Account _____ \$130.00.

A duplicate of this petition is attached.

If any additional petition fees are due, please charge Account 18-1829


SIGNATURE OF PRACTITIONER

Reg. No. 44,704

Elie H. Gendloff
(type or print name of practitioner)

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